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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/081,438 | 02/22/2002 | Gregory W. Kasten | 15904/31153 | 1005 |

21888 7590 01/04/2006

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| EXAMINER |
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AGWUMEZIE, CHARLES C

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/081,438 | KASTEN, GREGORY W. | |
| | Examiner | Art Unit | |
| | Charlie C. Agwumezie | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12 and 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/03/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1, and 13 are cancelled. Claims 2 and 14 are amended. Claims 2-12 and 14-24 are pending in this application per the response to office action filed on October 17, 2005.

Response to Arguments

2. Applicant's arguments with respect to claims 2-12 and 14-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 2-12 and 14-24**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dune, U.S. Patent Application Publication 2005/0075962 A1 in view of Herbst et al U.S. Patent No. 6,938,009 B1.

4. As per **claim 2 and 14**; Dunne discloses a method of rating a financial investment, comprising:

storing financial information about a plurality of financial investments including the financial investment and other financial investments (fig. 9; 0039; 0040); and

calculating an index for the financial investment based on a comparison of the financial information of the financial investment with the financial information of the other financial investments such that the index is predictive of the financial investment's future performance (see fig. 1 and 2 and 10; 0032) and calculating a percentile ranking for the financial investment for at least one trailing period of time (0010; 0079). What Dunne does not explicitly teach is:

wherein the financial investment has an expense ratio and a turnover rate, the financial information includes an average expense ratio, and an average turnover rate, and wherein the step of calculating the index comprises:

comparing the expense ratio to the average expense ratio to generate a compared expense ratio;

comparing the turnover rate to the average turnover rate to generate a compared turnover rate

Herbst et al discloses a method of rating a financial investment comprising:

wherein the financial investment has an expense ratio and a turnover rate, the financial information includes an average expense ratio, and an average turnover rate, and wherein the step of calculating the index comprises:

comparing the expense ratio to the average expense ratio to generate a compared expense ratio (see fig. 2; col. 7, lines 59 – col. 8, line 29);

comparing the turnover rate to the average turnover rate to generate a compared turnover rate (see fig. 2; col. 8, lines 4-29).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Dunne and incorporate the method, wherein the financial investment has an expense ratio and a turnover rate, the financial information includes an average expense ratio, and an average turnover rate, and wherein the step of calculating the index comprises: comparing the expense ratio to the average expense ratio to generate a compared expense ratio; comparing the turnover rate to the average turnover rate to generate a compared turnover rate as taught by Herbst et al in order to provide alternative method of calculating the index.

5. As per **claim 8 and 20**, Dunne further discloses the method, further comprising: comparing the index to a predetermined retention index; and identifying whether the financial investment should be included in or excluded from a financial investment plan based on the comparison (0061; 0072).

6. As per **claim 9 and 21**, Dunne further discloses the method, wherein the financial investment is identified to be excluded from the financial investment plan when the index exceeds the predetermined retention index (0061).

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7. As per **claim 10 and 22**; Dunne further discloses the method, wherein the financial investments is identified to be included in the financial investment plan when the index does not exceed the pre-determined retention index (0061).

8. As per **claim 11 and 23**; Dunne further discloses the method, further comprising identifying over time when the financial investment has at least one of the expense ratio which exceeds a maximum expense ratio, the turnover rate which exceeds a maximum turnover rate, the one year percentile ranking which exceeds a maximum one year percentile ranking, the three year percentile ranking which exceeds a maximum three year percentile ranking, and the five year percentile ranking exceeds a maximum five year percentile ranking such that the financial investment is identified to be excluded when at least one of the maximum expense ratio, the maximum turnover rate, the maximum one year percentile ranking, the maximum three year percentile ranking, or the maximum five year percentile ranking has been reached (0064; 0075; 0076).

9. As per **claim 3 and 15**, Dunne further discloses the method, wherein the step of calculating the percentile ranking comprises: calculating a one year percentile ranking for the financial investment for the past one year; calculating a three year percentile ranking for the financial investment for the past three years; and calculating a five year percentile ranking for the financial investment for the past five years (see fig. 1, 6 and 7; 0010).

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10. As per **claim 4 and 16**, Dunne further discloses the method, wherein the financial investment has a general investment category and a peer group category within the general investment category, and wherein the average expense ratio is based on the general investment category, the average turnover rate is based on the general investment category, and the one year, three year and five year percentile rankings are based on the peer group category (see fig. 6, 7 and 9; 0019; 0100).

11. As per **claim 5 and 17**, Dunne further discloses the method, wherein the step of calculating the index further comprises: weighting the compared expense ratio, the compared turnover rate, and the one year, three year and five year percentile rankings; and summing the weighted expense ratio, the weighted turnover rate and the weighted one year, three year and five year percentile rankings (fig. 2 and 10).

12. As per **claim 6 and 18**, Dunne further discloses the method, wherein the compared expense ratio is weighted at 20%, the compared turnover rate is weighted at 5% and the one year, three year and five year percentile rankings are each weighted at 25% (fig. 10).

13. As per **claim 7 and 19**, Dunne further discloses the method, wherein the general investment category is one of a U.S. equity category, an international equity category, a taxable bond category, a U.S. balanced fund category and an index fund category (0012).

14. As per **claim 12 and 24**, Dunne further discloses the method, further comprising calculating at least one of a median compared expense ratio, a median compared turnover rate, a median one-year percentile ranking, a median three-year percentile ranking and a median five year percentile ranking in the event at least one of the expense ratio, the turnover rate, the one year percentile rating, the three year percentile ranking and the five year percentile ranking is missing from the financial information (fig. 11).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

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may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlie C. L. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

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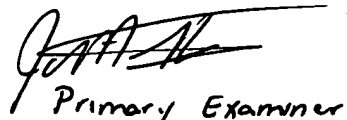
Alexandria VA. 22314

Charlie Lion Agwumezie

Patent Examiner

Art Unit 3321

November 18, 2005


Primary Examiner
Au 3621